

**REMARKS**

This responds to the Office Action mailed on March 8, 2006, and the references cited therewith.

Claims 1, 3, 4, 6, 14, 20, 28, and 29 are amended, claims 2, 7 and 19 are canceled; as a result, claims 1, 3-6, 8-18, and 20-29 are now pending in this application.

***Power of Attorney and Correspondence Address***

A Revocation and Power of Attorney, appointing the attorneys associated with Customer No. 49845, was filed with the U.S. Patent Office on July 21, 2005. Applicant requests that all future correspondence for this application be directed to Applicant's attorneys as follows:

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***Claim Objections***

Claims 3-4 and 6 were objected to as being dependent on cancelled claim 2.

Responsive to the objection, claims 3, 4 and 6 have been amended to depend on independent claim 1.

***§101 Rejection of the Claims***

Claims 1, 5, 7-12, 14-18 and 20-27 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Applicant respectfully submit that claims 1, 5, 7-12, 14-18 and 20-27 should not be rejected under 35 U.S.C. § 101 for the reason that the claimed inventions of independent claims 1, 14, and 20 achieve a final result that is concrete, tangible and useful.

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result.

"In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete."

USPTO OG Notices: 22 November 2005, Section IV, 2, b. Interim Guidelines for Examination of Patent Applications for Patent Subject matter Eligibility.

Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again.

Id. citing *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a Sec. 101 judicial exception, in that the process claim must set forth a practical application of that Sec. 101 judicial exception to produce a real-world result (emphasis added).

Id. citing *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77.

Claim 1 is a method of constructing category structures within a database such that a data item is user classifiable under a first hierarchy of categories in the database and not user-classifiable under a second hierarchy of categories in the database. This result is certainly repeatable and therefore concrete. Further, the result is practical and useful because the data item is user classifiable under the first hierarchy of categories in the database and alternatively classifiable under the second hierarchy of categories in the database though not user-classifiable under the alternative second hierarchy of categories in the database.

The Office Action states, "Defining a first structure of categories' and 'defining a second structure of categories' can be simply defining data in [a] person's mind to classify a data item." Applicant has amended the claim 1 to recite the term "database" in the body of the claim such that the amended claim 1 recites defining the first and second structure of categories in the "database." Further, Applicant respectfully points out that as of November 22, 2005 the Mental Step Test is not to be applied by examiners in determining whether the claimed invention is

patent eligible subject matter (USPTO OG Notices: 22 November 2005, "Interim Guidelines for Examination of Patent Applications for Patent Subject matter Eligibility, Annex 3, Improper Tests for Subject Matter Eligibility"). Most importantly "If a claimed process is performed by a machine, it is immaterial whether some or all the steps could be carried out by the human mind (Musgrave, 431, F.2d at 893, 167 USPQ at 289-90).

The above remarks may also be considered with respect to independent claim 14 that recites a method for classifying a data item within a database and the independent claim 20 that recites a method for facilitating the location of a data item within a database.

Claims 5 and 7-12, depend on independent claim 1; claims 15-18 depend on independent claim 14; and claims 20-27 depend on independent claim 20. If an independent claim is patentable subject matter under 35 U.S.C. § 101 then, any claim depending there from also includes patentable subject matter and rejection of claims 5, 7-12, 15-18 and 20-27 under 35 U.S.C. § 101 is also addressed by the above remarks.

Applicant respectfully submits that claims 1, 5, 7-12, 14-18 and 20-27 should not be rejected under 35 U.S.C. § 101 for the reason that the claimed inventions of independent claims 1, 14, and 20 achieves a final result that is concrete, tangible and useful.

#### §103 Rejection of the Claims

Claims 1, 3-12, 14-18 and 20-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ortega et al. (U.S. 6,489,968) in view of Fohn et al. (U.S. 6,460,025).

Applicant respectfully submits that claims 1, 3-12, 14-18 and 20-29 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claim 1 includes the following limitations:

defining the first structure of categories as a first hierarchy of categories in the database  
and defining the second structure of categories in the database as an alternative  
second hierarchy of categories...

...the data item is user-classifiable under the first structure of categories and is not user-classifiable under the second structure of categories.

The Office Action highlights category nodes C2 and C3 from Figure 1B of Ortega. The following quote may be relevant:

Fig. 1B illustrates a simple browse tree,...

Ortega, Col. 8, line 32

Claim 1 requires a data item that is user-classifiable under a first structure of categories defined as a first hierarchy of categories in the database and not user-classifiable under a second structure of categories defined as a second hierarchy of categories in the database. In contrast, Figure 1B of Ortega and does not illustrate a data item that is user-classifiable under a first hierarchy of categories and not user-classifiable under a second hierarchy of categories; but rather, a simple browse tree. Indeed, the Office Action states “Ortega does not explicitly disclose ‘the first hierarchy of categories and an alterative second hierarch of categories’” (Office Action, Page 4, bottom paragraph). Ortega therefore cannot be said to teach or suggest the above quoted limitation because Ortega describes a browse tree and claim 1 requires a data item that is user classifiable under a first structure of categories defined as a first hierarchy of categories in the database and not user classifiable under an alternative second structure of categories defined as a second hierarchy of categories in the database.

The above remarks are applicable to a consideration of independent claims 14 and 20.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 3-12, 15-18 and 21-27 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Ortega in combination with Fohn does not teach or suggest each and every limitation of claims 1, 14 and 20 as required to support rejections of the independent claims of the present application under 35 U.S.C. § 103.

**Documents Cited but Not Relied upon for this Office Action**

Applicant need not respond to the assertion of pertinence stated for the references cited but not relied upon by the Office Action since these references are not made part of the rejections in this Office Action. Applicant is expressly not admitting to this assertion and reserves the right to address the assertion should it form part of future rejections.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By his Representatives,

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Date 07/10/06

By \_\_\_\_\_

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 10 day of July, 2006.

Name



Signature